

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
BORODY, Thomas J.)	Art Unit: 4148
)	
Application No. 10/568,258)	Examiner: Ophelia A. Hawthorne
)	
Filing Date: June 30, 2006)	Confirmation No.: 9680
)	
For: IMPROVED ORAL OXYGENATING)	
APPLIANCE)	

RESPONSE TO FINAL OFFICE ACTION

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Ballard Spahr Andrews & Ingersoll, LLP
Customer No. 23859

December 19, 2008

Sir:

In response to the Final Office Action dated October 17, 2008, please consider the remarks herein.

Remarks begin on page 2 of this paper.

Remarks

Claims 1-21, 23, 24 and 28 remain in the application. Reconsideration of the rejections and objections at an early date is requested.

Claims 1-21 and 23, 24 and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hickie (Publication No. US2004/0129273 A1) in view of Albertelli (Publication No. US2005/0129273 A1).

The examiner has cited a new item of prior art (Albertelli) and argues that applicant's invention is obvious in light of a combination of Hickie and Albertelli. This combination is, however, completely inappropriate, and certainly would not have resulted in Applicant's invention.

The purpose of Awo2007003839pplicant's invention is to provide an endoscopic mouthguard that can operate effectively in post-operation recuperation as a means for providing continued gas distribution toward the mouth of the patient, after the bite block has been removed. This clearly requires the manifold to be held in position after the bite block has been removed (which Hickie does not show, as acknowledged by the examiner). By allowing the patient to be supplied with post-operative gas, the patient's mouth remains unaffected by the apparatus, and the patient can thus be given oral medication, liquids, food and the like while gas continues to be supplied to the patient.

Hickie does not disclose this advantageous apparatus, and Albertelli provides absolutely no assistance. More importantly, Albertelli does not describe an apparatus that has a dual purpose, and Albertelli certainly does not describe an apparatus where the patient's mouth remains unaffected by the gas supply means. Albertelli describes an apparatus for supplying a gas with dissolved radioactive material to a patient in a manner which does not allow the gas to contaminate the ambient environment. In other words, Albertelli describes a system where the entire volume of supplied gas is breathed by the patient, and is then filtered from the gas stream so that none of the radioactive

particles can enter the environment. The examiner, in line 8, page 4 of the office action, suggests that the tubing is detachable. Applicant certainly does not agree with the examiner on this point, but more importantly, any such detachment would constitute a failure of the Albertelli system because the Albertelli system is specifically designed not to become detached for the very purpose of ensuring radioactive material not be allowed to contaminate the atmosphere.

That arrangement is quite different from that claimed by the applicant. It will be noted that claim 1 requires that once the bite block is disengaged from the manifold, the manifold is adapted to direct gas to pass *over or towards the mouth of the patient*. Hickle does not suggest this capability, as has been acknowledged by the examiner, and Albertelli certainly provides no assistance because Albertelli discloses an apparatus where all gas passes through the patient, and great care is taken not to allow radioactive materials in the gas to contaminate the environment. This would hardly be possible if the Albertelli apparatus were somehow partially disconnected to allow gas to pass over or towards the mouth of the patient.

The applicant concedes that devices are known for attaching breathing masks or other breathing apparatus to the face of a patient. If that is the point of citing Albertelli, the point is conceded. However, what was not contemplated by Hickle was that the endoscopic mouthguard and gas supply manifold assembly could, once the mouthguard was removed from the patient, also be used to continue oxygenating the patient in a post operative environment. The post operative time and cost saving advantages of that arrangement are considerable, yet the possibility of achieving that dual purpose role was not appreciated by Hickle. For the reasons mentioned above, Albertelli provides absolutely no assistance or motivation to give the Hickle device this dual purpose advantage.

Moreover, one skilled in the art would not reasonably consider that Albertelli is so related to Hickle to combine the two references, or otherwise find any teaching or suggestion to do so. Albertelli is particularly designed to go into a patient's mouth. Since the point of

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the invention is to have the patient's mouth open for insertion of an endoscopic device, there would be no practical way to combine a device such as shown in Albertelli with the annular body (mouth piece) portion of the claimed invention. In fact, if anything, the design of Albertelli is such that, for one skilled in the art, it would teach away from any combination with the apparatus of Hickle.

The reasoning above applies also to the rejection of independent claims 21 and 28. Since the remaining claims are all dependent, either directly or indirectly on one of claims 1, 21 or 28, these claims should also be allowable.

Therefore, it is respectfully requested that the examiner withdraw her rejection and allow claims 1-21, 23, 24 and 28.

No fees are believed due. If, however, the Commissioner believes any additional fees are due, the Commissioner is hereby authorized to charge any such fee deficiency, or credit any fee overpayment, to Deposit Account No. 14-0629.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Sumner C. Rosenberg', is written over a horizontal line.

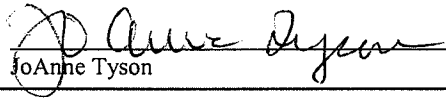
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CERTIFICATE OF EFS-WEB SUBMISSION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being transmitted via EFS-Web transmission on the date indicated below.


to Anne Tyson

Date 12/19/2008